

REMARKS

Applicant respectfully requests reconsideration in view of the amendment and following remarks. The applicant has rewritten claims 29 and 30 as newly added claims 31-32.

Claims 29 and 30 are rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 29 and 30 are rejected under 35 U.S.C. §101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of the process. Claims 1-26 are rejected under 35 U.S.C. §102(b) as being anticipated by US 5,641,848 A (Giacobbe et al.) ("Giacobbe"). The applicant respectfully traverses these rejections.

Rejections of Claims 29 and 30

Claims 29 and 30 are rejected under 35 U.S.C. §112, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 29 and 30 are rejected under 35 U.S.C. §101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of the process. The applicant believe that claims 31 and 32 (which replaced claims 29 and 30) are in compliance with 35 U.S.C. §§102 and 112, second paragraph. For the above reasons, these rejections should be withdrawn.

35 U.S.C. §102(b) Rejection

Claims 1-26 are rejected under 35 U.S.C. §102(b) as being anticipated by Giacobbe. The applicant's claimed invention is a cast film (which is non oriented film) wherein the applicant replaced conventional polypropylene homopolymer by a high crystalline propylene homopolymer in combination with a heterophasic polymer whereby stiffness, curl and cut ability

are improved (see page 1, lines 3-10 of the specification). These are all features which are very critical in a label application. So as a result of the applicant's new composition, the applicant was able to make a film which is highly suitable in label application, specifically label application wherein the labels are cut from the film roll and the individual labels are stacked. It is easier to handle the stacks, particularly the destacking fails rarely because the film is stiff and has low curl (see page 3, lines 7-11 of the specification).

The Examiner compares the heterophasic component of the applicant's invention with the heterophasic component of the Giacobbe. The applicant believes that the invention is clearly distinguished from Giacobbe by being characterized as a cast film versus the blown film and by the high crystalline polypropylene versus the broad molecular weight distribution polymer according to Giacobbe. Therefore, the applicant believes that it does not matter whether the heterophasic component is the same or not.

Enclosed is a copy of a section from Rosato's dictionary explaining that cast film and blown film are two technologies for making films which are distinct and different and have each specific critical problems which need to be addressed. One such problem of the blown film process is the thickness profile of the bubble and the bubble stability. These problems are addressed in Giacobbe (see col. 1, lines 50 - 60).

Such problems are not an issue for a cast film, because a bubble does not exist in such a cast process for making the film. Giacobbe teaches to improve bubble thickness profile and bubble stability by using a broad molecular weight distribution polymer. This does not provide any motivation or idea on how to solve the problem of stiffness and curl of a cast label film.

The terms appearing in a preamble may be deemed limitations of a claim when they give meaning to the claim and properly define the invention. *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994); *Catalina Mktg. Int'l., Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir.

2002) ([A] preamble limits the invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim.). Although no "litmus test" exists as to what effect should be accorded to words contained in a preamble, review of a patent in its entirety should be made to determine whether the inventors intended such language to represent an additional structural limitation or mere introductory language. *Id.* (citing *Corning Glass Works v. Sumitomo Electric USA, Inc.*, 868 F.2d 1252, 1257 (Fed. Cir. 1989). Accordingly, the PTO has allowed preamble language to be relied upon to distinguish an invention from the prior art. *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1347-48 (Fed. Cir. 2002). Read in light of the specification, the claims of the present application clearly describe a cast film and not a blown film as does Giacobbe.

Furthermore, applicant's specification indicates that the claims are directed at cast film specifically. Addressing facts very similar to those herein, the Federal Circuit held that where the preamble recites additional structure or steps that the specification deems important, the preamble may limit the claims. *See Corning Glass*, 868 F.2d at 1257. In *Corning Glass* the claim in question read: "An optical wave guide comprising..." The specification later went on to define "optical wave guide." The court held that the preamble limited the claim to optical wave guides because "optical wave guide" was later defined in the specification. *Id.*

Similarly, the present invention's specification defines and describes the characteristics of a cast film at least at pages 1 and 2. It is clear that the definition and characteristics of a cast film is important to an understanding of what was claimed and as a result the preamble should be given weight.

Here, the preamble of claim 1 contains the word cast film. So clearly the applicant's cast film is novel over a bubble film per se. For this reason alone this rejection should be withdrawn.

Moreover the broad molecular weight distribution polymer is not a high crystallinity polymer. The two polymers might have in common that they both have a broad molecular weight distribution, but a broad molecular weight distribution can be a characteristic of polymers with high crystallinity and it can also be a characteristic of polymers with low crystallinity. It seems the Examiner has overlooked the fact that the applicant's claim clearly refers to a film comprising a "high crystallinity" polypropylene which a specific propylene polymer. A broad molecular weight distribution does not tell anything about the degree of crystallinity of the polymer. These are two different completely independent parameters. There is nothing in Giacobbe that suggests to use a high crystallinity polymer in combination with the heterophasic polymer. In addition, Giacobbe does not suggest a high crystallinity polymer anywhere in the specification.

This is another reason that the applicant's cast film is also novel because the use of high crystallinity polypropylene in cast film is nowhere mentioned in Giacobbe.

As stated above, the object of the applicant's invention was to improve a film which should be suitable as a label film. The applicant has found that cast films made from this composition of high crystalline polypropylene and heterophasic polymer are very good label products because they have low curl, good stiffness and good cuttability.

There is nothing in Giacobbe that provides any motivation to choose a high crystallinity polypropylene for the broad molecular weight distribution polymer. Moreover a person of ordinary skill in the art could not derive from the teaching of the Giacobbe that a cast film of such composition will be advantageous in label application. So this raises the question, why should a person of ordinary skill in the label art choose to modify the blown film of Giacobbe into a cast film and to then choose a high crystalline polypropylene in the composition?

Giacobbe does not provide any motivation to do that. Therefore, the claims would not be rendered obvious over Giacobbe.

Claim 26

Claim 26 is further patentable because claim 26 is directed to a label made from the cast film of claim 1.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

A three month extension fee has been paid. Applicant believes no additional fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05581-00145-US from which the undersigned is authorized to draw.

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Respectfully submitted,

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Enclosure: inserts from Rosato's dictionary